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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,709	09/18/2000	Hiroyuki Fujita	001200	4404

7590

08/26/2003

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EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 08/26/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,709

Applicant(s)

FUJITA, HIROYUKI

Examiner

Anish Gupta

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The amendment filed 6-13-03 is hereby acknowledged. Claims 1-2 were amended and claims 5, 6, 9, 10 were canceled.

Withdrawn Rejections

2. The rejection of claims 5 and 6 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is hereby withdrawn.
3. The rejection of the claims, rejected under 35 U.S.C. 102(b) as being anticipated by Masayasu. (JP04069398) is hereby withdrawn.
4. The rejection of claims 1-10 rejected under 35 U.S.C. 102(b) as being anticipated by Suetsuna is hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7-8 remain rejected under 35 U.S.C. 102(b) as being anticipated by Yokoyama et al. for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to a angiotensin converting enzyme inhibitor.

Applicants argue that the reference does not teach membrane treatment of the hydrolyzate and thus, the content of a polypeptide having a molecular weight of at least 5000 is more than 10% by weight of the total hydrolyzate in the supernatant. Thus the composition is the same as claimed. Further, the a "polypeptide" is not included in the prior art composition.

Applicant's arguments filed 6-13-03 have been fully considered but they are not persuasive.

On page 6 of the specification, it is stated "[i]t is not suitable when a content of the polypeptide having a molecular weight of 5000 is over 10% by weight, because there are defects that hue will become yellow or brown, bitterness slightly remains to give unnatural flavor, and that aftertaste remains for a long time if the peptide I added to weak-flavored things, and further because inhibitory activity will not be improved." The reference teaches that "[t]hermolysin, as well as chymotrypsin or trypsin digest had no bitter taste [emphasis added] but had a good taste characteristic of dried bonito." (See page 1542 and 1544). Thus, since "no bitter taste" was present in the prior art composition, then one can conclude that the content of the polypeptide of 5000MW is less than 10%, otherwise bitter taste would be observed as discussed in the instant specification. It must not be forgotten, that the reference teaches the product. The mere fact that the reference does not teach a membrane step is inconsequential. The MPEP states that "[t]he patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from the product of the prior art, the claims is unpatentable even though the prior product was made by a different process." MPEP 2113. As for the polypeptide, since the composition is a digest of dried bonito, other polypeptides would be present after the centrifuge step.

Applicants arguments with regards to color and inhibitory activity is not found persuasive since the claims are drawn to a product. The reference discloses that product with inhibitory activity. All of the elements of the claims have been met.

Rejection is maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

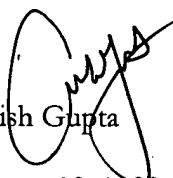
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can normally be reached on (703)306-3220. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Anish Gupta
August 20, 2003


BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
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